

PRE-APPEAL BRIEF REQUEST FOR REVIEWRE: Application No. **09/535,790**CUSTOMER No. **22927**

EXAMINER: ALVAREZ, Raquel

CONFIRM. No. **7017****REMARKS AND ARGUMENTS**

Applicants respectfully request Pre-Appeal Brief Review of the rejections set forth in the Final Office Action mailed May 9, 2006 (the “Final Office Action”). No amendments are being filed with this Request, and this Request is being filed concurrently with a Notice of Appeal.

A. Status of Claims

The Examiner indicates that claims **1-44, 47-74, 87, 94, 95, 144-153 and 162-167** are pending. However, we respectfully submit that claims **1-3, 5-21, 23-44 and 46-167** are pending, because the status of every claim ever filed in this application is as follows:

- Claims **1-167** were originally filed in the present application on March 29, 2003;
- Claims **75-86, 88-93, 96-143, and 154-161** were withdrawn from consideration in the Response filed on June 16, 2003, pursuant to a first restriction requirement imposed in the Office Action mailed on May 15, 2003;
- Claim **45** was cancelled by the Amendment mailed June 25, 2004; and
- Claims **4 and 22** were cancelled without prejudice in the Response filed March 1, 2006.

Consequently, the status of the claim is as follows:

- Claims **1-3, 5-21, 23-44 and 46-167** are pending;
- Claims **75-86, 88-93, 96-143, and 154-161** have been withdrawn from consideration;

- Claims 1-3, 5-21, 23-44, 46-74, 87, 94-95, 144-153 and 162-167 remain for consideration and stand rejected.
- Of the claims that remain for consideration, claims 1, 48, 58, 87, 94-95, 144-153 and 162-167 are independent claims.

B. The Section 103(a) Rejections

All of the pending claims under consideration, claims 1-3, 5-21, 23-44, 46-74, 87, 94-95, 144-153 and 162-167, stand rejected under Section 103(a) as allegedly being unpatentable over Von Kohorn, U.S. Patent No. 5,368,129 (hereinafter "Von Kohorn"). We respectfully submit that the Examiner has not made a *prima facie* case of obviousness for any pending claim.

As an initial item, we note that the Examiner did not recite any specific support for rejecting claims 3-8, 32-35, 37, 50-54, 57, 60 and 63-69 (See Final Office Action, second full paragraph on page 4). Although a general obviousness rejection was recited concerning all of the claims under consideration on page 2 of the Final Office Action, we assume that there is some subject matter not found in Von Kohorn that the Examiner was going to discuss, and / or that there is some subject matter in Von Kohorn that was going to be cited against these claims. Since we are unable to determine the exact grounds of rejection, we respectfully request a further Office Action that specifies the grounds of rejection at least as to claims 3, 5-8, 32-35, 37, 50-54, 57, 60 and 63-69 (please note that claim 4 was canceled in our response of March 1, 2006).

Independent claims 1, 48, 58, 87, 94-95, 144-153 and 162-167 recite methods, computer readable media, articles of manufacture, apparatus and systems for changing a benefit associated with a coupon. These claims each require a *qualifying action that is associated with a downstream recipient of the coupon*. The coupon benefit is changed when an indication is received of completion of the qualifying condition, or the coupon benefit is changed unless a notice is received that the qualifying action has not been completed.

In stark contrast, Von Kohorn pertains to a retail store coupon validating system that is typically located near the checkout counter, which validates a discount coupon and possibly awards a prize. The validating apparatus performs several functions, including randomly generating pay-off values for coupons, and randomly determining winners. Von Kohorn notes

that such operation can be similar to how "slot machines" operate, and advantageously "add(s) excitement to the shopping experience" and "adds to the interest and involvement of shoppers standing in a checkout counter line". (See Von Kohorn, col. 1, line 54 to col. 2, line 34, and the Abstract).

The Examiner recognized that Von Kohorn does not teach or suggest to update or change the value of a coupon based on a qualifying condition associated with a downstream recipient (See Final Office Action, paragraph spanning pages 2 and 3). In fact, Von Kohorn does not describe or even contemplate multiple recipients of the same or similar coupon (such as the downstream recipients described in Applicants' specification), much less changing a coupon's value based on a qualification condition associated with such a downstream recipient. But the Examiner took "Official Notice" in an attempt to remedy these deficiencies of Von Kohorn. In particular, the Examiner stated:

".... that it is "old and well known, in chain referral sales... for a seller to induce a buyer to purchase merchandise by promising to give the buyer a discount or a rebate if the buyer furnishes the seller with the names of other prospective buyers... It would have been obvious... to have included updating benefit (sic. "the benefit") of said coupon in association with a first recipient of said coupon and said qualifying action is associated with a second recipient of said coupon, wherein said second recipient is a downstream recipient of said first recipient; providing an indication to said first recipient of a completion of said qualifying action by said second recipient in order to obtain the above mentioned advantage." (See Final Office Action, paragraph spanning pages 2 and 3.)

We traversed this use of "Official Notice" in our Response of March 1, 2006, so the Examiner cited an article entitled "How MileNet Works" (hereinafter "MileNet") for support (see Final Office Action, paragraph 4, on pages 5-6). But MileNet describes a shareware computer program that enables a user to obtain frequent flyer miles for every minute that the user is connected to the Internet. The user runs the shareware program and has a "MileNet window" visible on the desktop. The user can also transmit the shareware program to a friend who can then install and use it, which will cause the user's "MileNet counter" increment speed to be increased. The friend in turn sends the shareware program to other friends who install and use it, which will cause the user's "MileNet counter" increment speed to be further increased (See page 1 of MileNet).

We respectfully submit that the MileNet shareware computer program is non-analogous art to that of the retail store discount coupon system disclosed by Von Kohorn. In particular, one skilled in the art would not consider MileNet when trying to solve a problem concerning discount coupons in a retail store environment. Von Kohorn teaches methods and systems that *randomly* determine coupon payoffs and that *randomly determine winners* (See Von Kohorn, col. 1, lines 64-66 and col. 2, lines 22-25). Such features are *contrary* to the operation of the MileNet shareware computer program, which operates *non-randomly* to systematically provide frequent flyer miles to users. We therefore submit that MileNet would not and cannot be used to supplement or clarify the teachings of Von Kohorn.

In addition, there is no motivation, teaching or suggestion to combine Von Kohorn and MileNet. The Examiner merely stated that it would have been obvious to include the teachings of MileNet with Von Kohorn:

“...because such a modification would allow the users to increase their points based on their friends and family actions”. (See Final Office Action, paragraph 4, pages 5-6).

But such a combination would necessarily have to either obviate the *required random* generation of coupon values and *random* determination of winners taught by Von Kohorn, or totally *disregard* the key feature of *systematically* awarding frequent flyer points to a user who is running the shareware program and who has disseminated the shareware program to other users who are running the shareware program, as taught by MileNet. Consequently, we respectfully assert that the Examiner has not provided any basis for modifying the Von Kohorn reference as suggested, and thus has not met the requirements for establishing a *prima facie* case of obviousness.

C. Conclusion

For the reasons set forth above, we respectfully request review and reversal of all of the Section 103(a) rejections of the pending and non-withdrawn claims **1-3, 5-21, 23-44, 46-74, 87, 94-95, 144-153 and 162-167**.

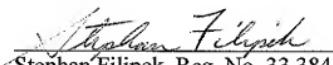
D. Petition for Extension of Time to Respond

Provided herewith is a petition for a two-month extension of time to respond, and the Commissioner is authorized to charge Deposit Account No. 50-0271 for the surcharge fee.

We do not believe that any other fees are due, but if a fee should be necessary to continue prosecution of the present application, please also charge any such required fee to our Deposit Account No. 50-0271. In addition, please credit any overpayment to Deposit Account No. 50-0271.

Respectfully submitted,

October 9, 2006
Date


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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

99-032

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Application Number

09/535,790

Filed

March 29, 2000

First Named Inventor

O'SHEA et al.

Art Unit

3622

Examiner

Raquel Alvarez

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

applicant/inventor.

assignee of record of the entire interest.

See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)

attorney or agent of record.

Registration number 33,384



Signature

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Registration number if acting under 37 CFR 1.34 _____

October 9, 2006

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required.
Submit multiple forms if more than one signature is required, see below*.

*Total of 1 forms are submitted.

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